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OFFICE OF PETITIONS

In re Application of :
Pinda, Mayer, Spieczny, Schmidt, :
Soloff, Rose, Reilly, and Bhamre : DECISION REFUSING STATUS
Application No. 09/839,502 : UNDER 37 CFR 1.47(a)
Filed: 20 April, 2001 :
For: COFFEE MAKER :
:

This is in response to the petition under 37 CFR 1.47(a), filed on 20 April, 2001.

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to respond, correcting the below-noted deficiencies. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on 20 April, 2001, with an executed oath or declaration naming Andres Pinda, Julianne Mayer, Steven Spieczny, David Soloff, Colleen Reily, and Neal Brahame as joint inventors and executed by joint inventors Rose, Mayer, Schmidt, and Speieczny on behalf of themselves and non-signing joint inventors Pinda, Soloff, Bhamre, and Reilly.

Also, on 20 April, 2001, the present petition was filed. Petitioners assert that a copy of the application was forwarded to joint inventors Pinda, Soloff, and Bhamre, but they failed to sign and return the declaration. Petitioners also assert that no

address for joint inventor Reilly could be located.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and
- (5) a statement of the last known address of the non-signing inventor.

The petition lacks items (1) and (5).

In regards to item (1), petitioners have not shown sufficient proof that a copy of the application (specification, including claims, drawings, if any, and the declaration) were sent to the non-signing inventors.¹ Although the petition states that a copy of the application was sent to joint inventors Pinda, Soloff, and Bhamre, it is unclear whether the statement was made with first hand knowledge. Petitioners should submit a copy of the cover letter transmitting the application papers to the non-signing inventors or details given in an affidavit or declaration of facts by a person having first hand knowledge of the details.

Additionally, petitioners have not shown that diligent efforts were made to obtain the last known address of joint inventor Reilly. The mere statement in the petition that efforts to contact Reilly were unsuccessful does not show that diligent efforts were made. Petitioners should attempt to obtain a last known address for Reilly from her former employer, the Internet, or directory or email searches.

Upon obtaining a last known address, a copy of the application should be sent to the inventor. If the application papers are returned as undeliverable, petitioners may show diligent efforts by providing a copy of an envelope showing that the application papers sent to the last known address of the non-signing inventor were returned as undeliverable by the post office. Details of the efforts made to locate the non-signing inventor should be set

¹MPEP 409.03(d).

forth in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

If the application is returned as undeliverable, petitioners should submit a copy of the envelope showing that the envelope addressed to the non-signing inventor at his last known address was returned as undeliverable by the post office. Details of the efforts made to locate the non-signing inventor must be set forth in an affidavit or declaration of facts by a person having first-hand knowledge of the details. Petitioner should also explain what attempts were made to obtain a forwarding address and to locate each inventor through other means. If attempts to obtain a forwarding address and to locate the inventor by other means (e.g. though e-mail or the telephone) continue to fail, then applicant will have established that the inventor cannot be reached.

If the inventor refuses in writing to sign the declaration after having been sent or given a copy, petitioners should submit a copy of the written refusal with any renewed petition. If a refusal is made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

In regards to item (2), petitioner has not submitted a proper oath or declaration in compliance with 37 CFR 1.63. Petitioners state that the address given in the petition for joint inventor Reilly is the address of her former employer. In situations where an inventor does not execute the oath or declaration, such as in an application filed under 37 CFR 1.47, the inventor's most recent home address must be given to enable the Office to communicate directly with the inventor. A new oath or declaration, signed by all the signing inventors,² is required. The declaration filed on 26 September, 2001, does not state that the person(s) making the oath or declaration acknowledge the duty to disclose to the Office all information known to the person(s) to be material to patentability as defined in 37 CFR 1.56. Rather, the declaration filed on 26 September, 2001, incorrectly acknowledges a duty to disclose all information material to examination of the application.

Additionally, it is noted that although the application transmittal sheet and the petition list joint inventor Rose as the first named inventor, the declaration states that joint inventor Pinda is the first named inventor and joint inventor

²MPEP 605.03

Rose is the sixth named inventor. The order of names of joint patentees in the heading of the patent is taken from the order in which the typewritten names appear in the original oath or declaration.³ Therefore, if petitioners desire that the order of names be other than as specified on the declaration filed with the application, a petition under 37 CFR 1.182 to change the order of inventors must be filed, accompanied by the requisite petition fee. Additionally, it is noted that the first named inventor's last name appears as "Pinda" on the declaration but as "Pineda" in other application papers. As the inventorship is determined by the executed oath or declaration, a petition under 37 CFR 1.182 to correct an inventor's name, accompanied by the requisite petition fee, must be filed if an inventor's name is not correctly spelled on the declaration. A new oath or declaration in compliance with 37 CFR 1.63 and 1.67 must be submitted with any renewed petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 308-6918.



Douglas I. Wood
Petitions Attorney
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Office of the Deputy Commissioner
for Patent Examination Policy

³MPEP 605.04(f).